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Atty. Docket: 15-UL-5584

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application:

Charles C. Brackett : Group Art Unit: 3626

Serial No.: 09/557,153 : Examiner: Frenel, V.

Filed: April 24, 2000

Title: IMAGING SYSTEM HAVING MEANS FOR
CREATING, MANAGING AND SELECTING
FROM A LIST OF EXAM DESCRIPTIONS

Hon. Commissioner of Patents & Trademarks
Washington, D.C. 20231

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AMENDMENT AFTER FINAL REJECTION

Sir:

In response to the Office Action dated April 5, 2004, the Applicant traverses the Final Rejection, which fails to establish a *prima facie* case of obviousness and which asserts new grounds of rejection.

A R G U M E N T

In the Office Action dated October 7, 2003, claims 19-35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,272,470 to Teshima in view of U.S. Patent Application Pub. No. 2001/0018659 to Koritzinsky.

In contrast, in the Final Rejection the Examiner asserts that the claims are "either . . . fully disclosed or obvious in view of the collective teachings of Teshima, and/or Koritzinsky". The use of the phrase "fully disclosed" and the citation of Teshima or Koritzinsky, i.e., in the alternative, are clearly new grounds for rejection. In the Final Rejection,

the Examiner has backpedaled from his reliance on Koritzinsky and placed sole reliance on Teshima.

This is also evidenced by the Examiner's rebuttal to Applicant's argument submitted by Amendment filed on January 12, 2004. In the Amendment, Applicant argued that Koritzinsky did not disclose certain limitations recited in the rejected claims. The Examiner acknowledges this argument on page 2 of the Final Rejection, referring to Applicant's second argument, to wit, that "Koritzinsky does not disclose any of the recited features". In rebuttal to Applicant's second argument, the Examiner states:

With respect to Applicant's second argument, Examiner respectfully suggests that Teshima discloses selecting an exam description from a stored list of exam descriptions . . .

{Page 3 of Office Action dated April 5, 2004.} It boggles the mind to think that in response to the argument that Reference B does not disclose the recited feature, the Examiner asserts that Reference A discloses the recited feature. What could be a clearer new ground for rejection.

Moreover, the Examiner says nothing in defense of his previous position that the recited features could be found in Koritzinsky. Since Applicant's assertion that Koritzinsky does not disclose the recited features has not been rebutted by the Examiner, the rejection in reliance on Koritzinsky must be withdrawn. Withdrawal of the rejection cannot be avoided by the subterfuge of injecting the word "or" into the Final Rejection

and citing Koritzinsky in the alternative.

Furthermore, in the October 7, 2003 action, the Examiner conceded:

Teshima does not explicitly disclose an exam list manager for controlling said display screen to display a second screen in place of said first screen in response to a second selection input by the operator via said operator interface, said second screen comprising a multiplicity of Exam Description fields in list format for displaying a corresponding multiplicity of exam descriptions in a stored linked list of exam descriptions arranged in alphabetic order, an Edit field in which the operator can enter an exam description to be added to said linked list, and a first activation zone for activating the insertion in alphabetic order of the exam description in said Edit field to said displayed list of exam descriptions in response to clicking on said first activation zone via said operator interface, wherein said control platform further controls said display screen to display an updated version of said first screen in place of said second screen in response to selection of one of said exam descriptions displayed on said second screen via said operator interface followed by a third selection input by the operator via said operator interface, said Exam Description field of said updated version of said first screen displaying said selected exam description.

[emphasis added]. With the exception of the words "Teshima does not explicitly disclose", the entire extract is taken verbatim from Applicant's claim 19, lines 10-31. In other words, in the October 7, 2003 action the Examiner conceded that two-thirds of the limitations in claim 19 were not disclosed in Teshima! The Final Rejection now concedes that these limitations cannot be found in Koritzinsky either. **The Applicant respectfully requests that the Examiner explain how claim 19 can be unpatentable over Teshima in view of Koritzinsky when neither reference discloses 21 lines of limitations in claim 19?** In light of this huge

lacuna in the Examiner's theory of rejection, it is embarrassing for the Examiner to assert that the burden of presenting a *prima facie* case of obviousness "since he has presented evidence of corresponding claim elements in the prior art"!

In addition, the Applicant rejects the Examiner's boilerplate assertion that "Applicant does not point to any specific distinction(s) between the features disclosed in the references and the features that are presently claimed." This groundless assertion is belied by the Examiner's very own preceding words on page 2, to wit, that Applicant has argued that neither of two functions can be found in either reference, those functions being:

- (a) inserting a new exam description (contained in the Edit field) into the list, both the list and the Edit field being displayed on the second screen; and (b) filling an Exam Description field on an updated version of the first screen with the exam description selected from the linked list by the system operator.

The quoted text is claim language, and the Examiner concedes that the Applicant has argued this claim language is not found in either reference. Therefore, how can it be that "Applicant does not point to any specific distinction(s) between the features disclosed in the references and the features that are presently claimed"?

The undersigned wishes to express his extreme dissatisfaction with the examination history in this case. The latest Final Rejection is the fourth office action in this case. In each office action, all claims were rejected for spurious

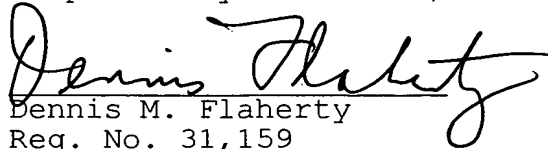
reasons. In response to the first Final Rejection dated April 9, 2003, Applicants requested that the finality of the Final Rejection be withdrawn because new grounds of rejection had been presented. Now the same procedural gaffe has been repeated in the latest Final Rejection. Responding to these repeated spurious rejections has cost the assignee dearly in attorney's fees and patent rights not yet issued. It is respectfully requested that someone with supervisory authority intervene in the examination of this application and take appropriate action.

The undersigned further notes that the Final Rejection is not signed by either the assigned examiner, Vanel Frenel, or by the examiner's supervisor, Joseph Thomas. Since the signature is illegible, the undersigned has no idea whom to call to discuss the Final Rejection. If the Primary Examiner who signed the Final Rejection is someone who has had no prior involvement in this case, this might very well explain why new grounds of rejection have been presented.

In summary, the Final Rejection is a complete and utter muddle and should be withdrawn.

June 7, 2004
Date

Respectfully submitted,


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